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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,626	10/12/2000	James A. Satchell JR.	TPP31333	6147

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Stevens, Davis, Miller & Mosher
1615 L St., N.W., Suite 850
Washington, DC 20036

EXAMINER

GARLAND, STEVEN R

ART UNIT PAPER NUMBER

2121

DATE MAILED: 12/17/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/686,626

Applicant(s)

SACHELL ET AL.

Examiner

Steven R Garland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2001 and 05 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

2. Claims 1-59 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

4. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

5. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

6. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,822,216 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

7. The drawings are objected to because they are not clean copies of the patent drawings. Note the Office will not transfer the drawings from the patent file to the reissue application. A proposed drawing correction or corrected drawings are required

in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. Claims 13-30 and 42-59 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The retrofitting door aspects have been omitted from claims 13-30 and 42-59 resulting in improper recapture. The retrofitting door was indicated as being the reason for allowance of originally numbered claim 10 in the parent patent in the office action of 10/6/97. Further in the amendment filed 12/30/97 by the applicant it was stated that claim 1, the only other independent claim in the application, was being amended to recite a vending machine having a door for retrofitting an existing vending machine consistent with allowable claim 10. The response further stated that in view of the indication of Allowability of claim 10, these amendments are submitted to place claim 1

in condition for allowance with all the other remaining claims being dependent on claim 1 as amended. The application was then allowed without additional amendment and no additional comments in regards to the allowed claims were made by the applicants. All the rejected claims fail to claim the retrofitting door. Also note MPEP section 1412.02 on recapture.

9. It is noted that the U.S. application 08/429583 was given the filing date of 08/17/95 on the basis of the specification and drawings originally filed 4/27/95. The specification and drawings as originally filed 4/27/95 do not specifically mention the term "Internet". Also the 08/429583 was filed by a sole inventor. The introduction of the term "Internet" appears in the 08/715232 application filed by joint inventors, which application 08/715232 is a continuation in part application of the 08/429583 application, and on the basis of the added subject matter including the term "Internet" the current application is only entitled to the filing date of the 08/715232 application in regards to Internet subject matter. Note is also taken applicant's definition of "Internet" in col. 4, lines 39-41.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 37-41, 44-46, and 51-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 38, line 4, it is unclear which of the signals "said audio and video signals" are being referred to i.e. the ones down or uploaded or the ones from the camera and microphone. Claim 51 has a similar problem.

In claim 37, line 1, "said computer assembly" lacks a proper antecedent basis.

Claim 39, line 6, "the Internet access" lacks a proper antecedent basis. Claim 52 has a similar problem.

Claim 41, line 1, "said at least one" lacks a clear antecedent basis.

In claim 53, line 1, "said audio-video mechanism" lacks an antecedent basis.

Claim 44, line 3, the phrase "and substitutes therefore" is indefinite as to what is being claimed. Claim 54, lines 6 and 9, have similar problems.

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 36, 46, and 48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 36, line 3, the examiner can find no specific basis in the original specification for the selected item being "bills" now being claimed. Similar comments apply to claim 48.

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In claim 46, line 2, the examiner can find no specific basis in the original specification for the software for return of payment for at least one of Internet access.

These new limitations are be new matter, since the original disclosure does not support the new specific limitations now being claimed.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

15. Claims 26, 28-30, 55-57, and 59 are rejected under 35 U.S.C. 102(e) as being anticipated by Bernstein et al. 5,761,071

Bernstein et al. disclose a vending machine, such as a ATM, with Internet access, use of a computer, modem or antenna, display of information when the machine is idle. See the abstract, figures, col. 1, line 9 to col. 2, line 52; col. 3, line 66 to col. 4, line 22; and col. 7, lines 25-33.

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16. Claims 13, 15-26, 28-30, 42-44, 47-53, and 55-59 are rejected under 35

U.S.C. 102(e) as being anticipated by Barcelou 6,048,271.

Barcelou discloses a kiosk that can vend products and also perform other functions. Barcelou discloses the use of a computer; accepting and dispensing cash; credit, etc.; use of a camera to record an image on a medium; use of the kiosk to access Internet services; use of a card reader; recording on cards, disks, etc.; and advertising. See the abstract; figures; col. 2, lines 43-55; col. 3, line 17 to col. 4, line 63; col. 5, line 10 to col. 6, line 6; and col. 7, line 52 to col. 9, line 23.

17. Claims 13-26, 28-30, and 42-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Peters 5,769,269.

Peters discloses a computer controlled vending machine; use of a ISDN connection (Internet); use of live video/audio; recording audio/video signals; use of a modem; use of a camera and microphone; advertising; use of debit/credit cards; use of a keyboard; money return; use of a door; etc. See the abstract; figures; col. 1, line 15 to col. 3, line 59; and col. 4, line 45 on.

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peters 5,769,269 in view of Christiansen et al. 5,748,485.

Peters discloses a computer controlled vending machine; use of a ISDN connection (Internet); use of live video/audio; recording audio/video signals; use of a modem; use of a camera and microphone; advertising; use of debit/credit cards; use of a keyboard; money return; use of a door; etc. See the abstract; figures; col. 1, line 15 to col. 3, line 59; and col. 4, line 45 on.

Peters however does not specifically state that part of the access means is on the door.

Christiansen et al. specifically teaches putting various elements on the door of a vending machine such as a bill acceptor. See col. 5, lines 11-35.

It would have been obvious to one of ordinary skill in the art to modify Peters in view of Christiansen et al. and put part of the access means on the door such as the money acceptor or card reader. This would allow for ease in separating and servicing various components in the machine.

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21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ishizaki et al. 5,699,328; Jacobs 5,550,746; and Ogram 5,822,737 also teach Internet access from a vending machine. Fischetti et al. 4,789,907 is of interest in recording using a vending machine.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R Garland whose telephone number is 703-305-9759. The examiner can normally be reached on Monday-Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Grant, can be reached on (703) 308-1108. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239; for after final faxes 703-746-7238; and for non official faxes 703-746-7240.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3900.

SRG
Steven R Garland
Examiner
Art Unit 2121

W Grant
WILLIAM GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100
12/10/01